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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/668,711 | 09/22/2003 | Barry W. Hutzal | DON01 P-1115 | 2216 |
| 28101 | 7590 | 04/15/2004 | EXAMINER | |
| VAN DYKE, GARDNER, LINN AND BURKHART, LLP | | | SHAHER, RICKY D | |
| 2851 CHARLEVOIX DRIVE, S.E. | | | ART UNIT | |
| P.O. BOX 888695 | | | PAPER NUMBER | |
| GRAND RAPIDS, MI 49588-8695 | | | 2872 | |

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|---------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/668,711 | HUTZEL ET AL. | |
| | Examiner | Art Unit | |
| | Ricky D. Shafer | 2872 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 110-125 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 110-125 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 111-113, drawn to an interior rearview mirror assembly comprising a rearview mirror assembly and information display with particular reflective element details (electrochromic reflective element), classified in class 359, subclass 265.
 - II. Claims 114-116, drawn to an interior rearview mirror assembly comprising a rearview mirror assembly, an information display and a camera, classified in class 348, subclass 148.
 - III. Claim 119, drawn to an interior rearview mirror assembly comprising a rearview mirror assembly, an information display and at least one light emitting diode, classified in class 340, subclass 815.45.
 - IV. Claims 120-122, drawn to an interior rearview mirror assembly comprising a rearview mirror assembly, an information display and a housing with particular housing details, classified in class 340, subclass 815.83.
 - V. Claims 123 and 124, drawn to an interior rearview mirror assembly comprising a rearview mirror assembly, an information display and a mirror casing with particular mirror casing details, classified in class 359, subclass 865.
 - VI. Claim 125, drawn to an interior rearview mirror assembly comprising a rearview mirror assembly, an information display, a mirror casing and at least one indicator, classified in class 359, subclass 871.
2. Claim 110 link(s) inventions I-VI. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 110. Upon the allowance

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of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claims 117 and 118 link(s) inventions III and IV. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 117 and 118. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. The inventions are distinct, each from the other because of the following reasons:

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Inventions [II, III, IV, V, VI] and I are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of the particular reflective element details (electrochromic reflective element). The subcombination has separate utility such as an interior rearview mirror assembly without a camera, at least one light emitting diode, a housing with particular housing details, a mirror casing with particular mirror casing details or indicator.

Inventions II-VI are related as subcombinations disclosed as usable together in a single combination or are patentably distinct each from the other as noted by their separate details. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of the inventions II-VI have separate utility such as an interior rearview mirror assembly with the separate details of the other invention(s). For example, the interior rearview mirror assembly of group II has separate utility as an interior rearview mirror assembly without at least one light emitting diode of group III, the particular housing details of group IV, the particular mirror casing details of group V or the indicator of group VI, the interior rearview mirror assembly of group III has separate utility as an interior rearview mirror assembly without the particular housing details of group IV, the particular mirror casing details of group V, the indicator of group VI or the camera of group II, the interior rearview mirror assembly of group IV has separate utility as an interior rearview mirror assembly without the particular mirror casing details of group V, the indicator of group VI, the camera of group II or at least one light

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emitting diode of group III, the interior rearview mirror assembly of group V has separate utility as an interior rearview mirror assembly without the indicator of group VI, the camera of group II, at least one light emitting diode of group III or the particular housing details of group IV...etc.

See MPEP § 806.05(d).

Inventions VI and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of the particular mirror casing details (the casing having a recessed portion extending into the casing behind a reflective element for receiving the information display). The subcombination has separate utility such as an interior rearview mirror assembly without the casing including at least one indicator.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

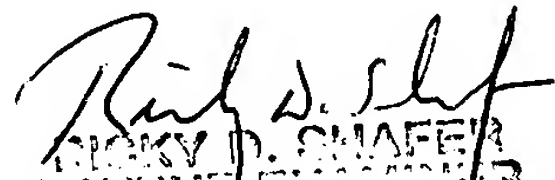
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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R.D. Shafer whose telephone number is (571) 272-2320.

RDS

April 13, 2004


RICKY D. SHAFER
PATENT EXAMINER
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